Supreme Court U.S.
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No. 02-193

In The

Supreme Court of the United States

INTERMATIC INCORPORATED,

Petitioner,

v.

THE LAMSON & SESSIONS CO.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

REPLY TO BRIEF IN OPPOSITION

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The clearest case for GVR is where the decision of the lower court was based on a rule of law that has since been rejected by an intervening decision of this Court. *Lawrence v. Chater*, 516 U.S. 163, 166 (1996).[1] The instant case satisfies the standard articulated in *Lawrence* (*i.e.*, the intervening decision is "sufficiently analogous, and, perhaps, decisive") because the Federal Circuit's decision was based squarely on the very decision that was vacated by *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushki Co.*, 122 S. Ct. 1831 (2002). As such, this Court's decision in *Festo* is *per se* decisive. GVR is appropriate in this case for the same reason it was appropriate in the numerous other cases for which this Court granted GVR in light of *Festo*. *See* Pet. 8; *see also Talbert Fuel Sys. Patents v. Unocal Corp.*, No. 02-90, 2002 WL 1611491 (October 7, 2002); *Simple Tech., Inc. v. Dense-Pac Microsystems, Inc.*, No. 01-1787, 2002 WL 1304925 (October 7, 2002). Lamson makes no attempt to distinguish the present case from the cited cases.

Contrary to Lamson's suggestion, Intermatic does not need to prove that the Federal Circuit would reach a different result on remand in order to justify GVR. GVR is not a decision on the merits, but simply a remand to the appellate court so that it may consider a binding decision

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[1] Even the dissent in *Lawrence* noted that GVR is necessary in view of intervening law to "preserve the operational premise of a multitiered judicial system (viz., that lower courts will have the first opportunity to apply the governing law to the facts) and to avoid the unseemliness of holding judgments to be in error on the basis of law that did not exist when the judgments were rendered below." *Id.* at 181 (Scalia, J., dissenting).

that was not previously before it. *See Henry v. City of Rock Hill*, 376 U.S. 776, 777 (1964).

Even though Intermatic need not show that the remand will lead to a different result, Intermatic's petition provides a strong reason why the Federal Circuit would reach a different result (Pet. 7-8). Lamson's citation of *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336 (Fed. Cir. 2002) did not change the rule that, given a clear indication, the identical term *can* have a different range of equivalents in different claims. *Am. Permahedge, Inc. v. Barcana, Inc.*, 105 F.3d 1441, 1446 (Fed. Cir. 1997). Such a clear indication is present in this case because Intermatic did not surrender any equivalents relating to claims that previously had been allowed.

Moreover, Lamson's attempt to force Intermatic to defeat a post-*Festo* defense based on a pre-*Festo* record is inappropriate. The estoppel analysis announced in *Festo* raises a number of factual and legal questions that the parties have not discovered or briefed (Pet. 7-8). The Federal Circuit has recognized that pending cases may require additional briefing and fact finding in order to answer the questions presented under the new *Festo* estoppel analysis. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushki Co.*, 304 F.3d 1289 (Fed. Cir. 2002) (ordering briefing on remand regarding, *inter alia*, whether the estoppel analysis involves questions of law or fact, the role of the jury, and the need for further fact finding in the district court). This is not a court of first impression – the questions raised in this Court's *Festo* decision must be addressed for the first time in the court(s) below.

GVR is proper in this case. GVR guarantees Intermatic full and fair consideration of its rights in light of the

intervening *Festo* decision. To protect judicial integrity, the Federal Circuit should be given the opportunity to reconsider its holding in view of the new rule of law articulated in the intervening *Festo* decision.

Respectfully submitted,

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